



9-19-06

/IFW

188.611

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: :  
Gunter Eisenhardt :  
Serial No.: 10/569,765  
Filed: February 23, 2006  
For: VALVE TIMING MECHANISM

Hedman & Costigan  
1185 Avenue of the Americas  
New York, NY 10036  
September 13, 2006

**LETTER**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicants are enclosing herewith an English translation of the instructional preliminary report of patentability issued in the PCT application corresponding to the above application.

Respectfully submitted,

Hedman and Costigan

Charles A. Muserlian, 19,683  
Attorney for Applicant(s)  
Tel.: # (212) 302-8989


CAM:agg  
Enclosures



"EXPRESS MAIL" Mailing Label Number: ED 555 608 797 US

Date of Deposit: September 13, 2006

I hereby certify that this correspondence is being deposited with the United States Postal Service "EXPRESS MAIL POST OFFICE TO ADDRESSEE: Service under 37 CFR 1.10 on the date indicated above and is addressed to the Commissioner for Patents, P.O. Box 1450 Alexandria, VA 22313-1450.

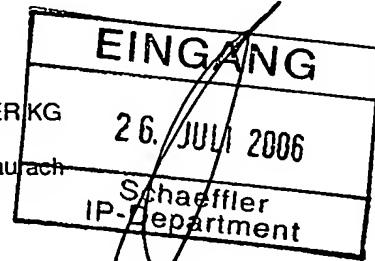
  
Alain-Gérard Pinset

**PCT**

NOTIFICATION OF TRANSMITTAL  
OF COPIES OF TRANSLATION  
OF THE INTERNATIONAL PRELIMINARY REPORT  
ON PATENTABILITY  
(CHAPTER I OR CHAPTER II  
OF THE PATENT COOPERATION TREATY)  
(PCT Rules 44bis.3(c) and 72.2)

To:

INA-SCHAEFFLER KG  
Industriestr. 1-3  
91074 Herzogenaurach  
ALLEMAGNE



Date of mailing (day/month/year) 20 July 2006 (20.07.2006)	<b>IMPORTANT NOTIFICATION</b>
Applicant's or agent's file reference 4255-16-WO <i>Re</i>	
International application No. PCT/EP2004/008066	International filing date (day/month/year) 20 July 2004 (20.07.2004)
Applicant INA-SCHAEFFLER KG et al	

## 1. Transmittal of the translation to the applicant.



The International Bureau transmits herewith a copy of the English translation of the international preliminary report on patentability (Chapter I).



The International Bureau transmits herewith a copy of the English translation of the international preliminary report on patentability (Chapter II).

## 2. Transmittal of the copy of the translation to the designated or elected Offices.

The International Bureau notifies the applicant that copies of that translation have been transmitted to the following designated or elected Offices requiring such translation:

None

The following designated or elected Offices, having waived the requirement for such a transmittal at this time, will receive copies of that translation from the International Bureau only upon their request:

AE, AG, AL, AM, AP, AT, AU, AZ, BA, BB, BG, BR, BW, BY, BZ, CA, CH, CN, CO, CR, CU, CZ, DE, DK, DM, DZ, EA, EC, EE, EG, EP, ES, FI, GB, GD, GE, GH, GM, HR, HU, ID, IL, IN, IS, JP, KE, KG, KP, KR, KZ, LC, LK, LR, LS, LT, LU, LV, MA, MD, MG, MK, MN, MW, MX, MZ, NA, NI, NO, NZ, OA, OM, PG, PH, PL, PT, RO, RU, SC, SD, SE, SG, SK, SL, SY, TJ, TM, TN, TR, TT, TZ, UA, UG, US, UZ, VC, VN, YU, ZA, ZM, ZW

## 3. Reminder regarding translation into (one of) the official language(s) of the elected Office(s).

The applicant is reminded that, where a translation of the international application must be furnished to an elected Office, that translation must contain a translation of any annexes to the international preliminary report on patentability (Chapter II).

It is the applicant's responsibility to prepare and furnish such translation directly to each elected Office concerned within the applicable time limit (Rule 74.1). See Volume II of the PCT Applicant's Guide for further details.

The International Bureau of WIPO  
34, chemin des Colombettes  
1211 Geneva 20, Switzerland

Facsimile No. +41 22 338 82 70

Authorized officer

Agnes Wittmann-Regis

Facsimile No. +41 22 338 82 70

# PCT

## INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY (Chapter I of the Patent Cooperation Treaty)

(PCT Rule 44bis)

Applicant's or agent's file reference 4255-16-WO	<b>FOR FURTHER ACTION</b>	See item 4 below
International application No. PCT/EP2004/008066	International filing date ( <i>day/month/year</i> ) 20 July 2004 (20.07.2004)	Priority date ( <i>day/month/year</i> ) 05 September 2003 (05.09.2003)
International Patent Classification (8th edition unless older edition indicated) See relevant information in Form PCT/ISA/237		
Applicant INA-SCHAEFFLER KG		

1. This international preliminary report on patentability (Chapter I) is issued by the International Bureau on behalf of the International Searching Authority under Rule 44 bis.1(a).

2. This REPORT consists of a total of 5 sheets, including this cover sheet.

In the attached sheets, any reference to the written opinion of the International Searching Authority should be read as a reference to the international preliminary report on patentability (Chapter I) instead.

3. This report contains indications relating to the following items:

- |                                                |                                                                                                                                                                 |
|------------------------------------------------|-----------------------------------------------------------------------------------------------------------------------------------------------------------------|
| <input checked="" type="checkbox"/> Box No. I  | Basis of the report                                                                                                                                             |
| <input checked="" type="checkbox"/> Box No. II | Priority                                                                                                                                                        |
| <input type="checkbox"/> Box No. III           | Non-establishment of opinion with regard to novelty, inventive step and industrial applicability                                                                |
| <input type="checkbox"/> Box No. IV            | Lack of unity of invention                                                                                                                                      |
| <input checked="" type="checkbox"/> Box No. V  | Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement |
| <input type="checkbox"/> Box No. VI            | Certain documents cited                                                                                                                                         |
| <input type="checkbox"/> Box No. VII           | Certain defects in the international application                                                                                                                |
| <input type="checkbox"/> Box No. VIII          | Certain observations on the international application                                                                                                           |

4. The International Bureau will communicate this report to designated Offices in accordance with Rules 44bis.3(c) and 93bis.1 but not, except where the applicant makes an express request under Article 23(2), before the expiration of 30 months from the priority date (Rule 44bis .2).

The International Bureau of WIPO 34, chemin des Colombettes 1211 Geneva 20, Switzerland  Facsimile No. +41 22 338 82 70	Date of issuance of this report 10 July 2006 (10.07.2006)
	Authorized officer  Agnes Wittmann-Regis  e-mail: pt06@wipo.int

# PATENT COOPERATION TREATY

From the  
INTERNATIONAL SEARCHING AUTHORITY

# PCT

**Translation**

WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY

(PCT Rule 43bis.1)

To:

Date of mailing (day/month/year) **See form PCT/ISA/210**

Applicant's or agent's file reference

**4255-16-WO**

**FOR FURTHER ACTION**

See paragraph 2 below

International application No.

**PCT/EP2004/008066**

International filing date (day/month/year)

**20.07.2004**

Priority date (day/month/year)

**05.09.2003**

International Patent Classification (IPC) or both national classification and IPC

**F01L1/24, F01L1/18**

Applicant

**INA-SCHAEFFLER KG**

1. This opinion contains indications relating to the following items:

- ☒ Box No. I Basis of the opinion
- ☒ Box No. II Priority
- ☐ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- ☐ Box No. IV Lack of unity of invention
- ☒ Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability: citations and explanations supporting such statement
- ☐ Box No. VI Certain documents cited
- ☐ Box No. VII Certain defects in the international application
- ☐ Box No. VIII Certain observations on the international application

2. **FURTHER ACTION**

If a demand for international preliminary examination is made, this opinion will be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA") except that this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of 3 months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

3. For further details, see notes to Form PCT/ISA/220.

Name and mailing address of the ISA/EP

Authorized officer

Facsimile No.

Telephone No.

WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY

International application No.

PCT/EP2004/008066

Box No. 1

Basis of this opinion

1. With regard to the language, this opinion has been established on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.  
☐ This opinion has been established on the basis of a translation from the original language into the following language \_\_\_\_\_, which is the language of a translation furnished for the purposes of international search (under Rule 12.3 and 23.1(b)).
2. With regard to any nucleotide and/or amino acid sequence disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:
  - a. type of material  
☐ a sequence listing  
☐ table(s) related to the sequence listing
  - b. format of material  
☐ in written format  
☐ in computer readable form
  - c. time of filing/furnishing  
☐ contained in the international application as filed.  
☐ filed together with the international application in computer readable form.  
☐ furnished subsequently to this Authority for the purposes of search.
3. ☐ In addition, in the case that more than one version or copy of a sequence listing and/or table(s) relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.
4. Additional comments:

WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY

International application No.

PCT/EP2004/008066

Box No. II

Priority

1. ☒ The following document has not yet been furnished:
  - ☒ copy of the earlier application whose priority has been claimed (Rule 43bis.1 and 66.7(a)).
  - ☐ translation of the earlier application whose priority has been claimed (Rule 43bis.1 and 66.7(b)).

Consequently it has not been possible to consider the validity of the priority claim. This opinion has nevertheless been established on the assumption that the relevant date in the claimed priority date.
2. ☐ This opinion has been established as if no priority had been claimed due to the fact that the priority claim has been found invalid (Rules 43bis.1 and 64.1). Thus for the purposes of this opinion, the international filing date indicated above is considered to be the relevant date.
3. Additional observations, if necessary:

WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY

International application No.  
PCT/EP2004/008066

Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability;  
citations and explanations supporting such statement

1. Statement

Novelty (N)	Claims	2-10	YES
	Claims	1	NO
Inventive step (IS)	Claims	2-10	YES
	Claims	1	NO
Industrial applicability (IA)	Claims	1-10	YES
	Claims		NO

2. Citations and explanations:

**V.1 Claim 1**

WO 00/20730 A (CECUR MAJO; EATON AUTOMOTIVE SPA (IT)) (2000-04-13); (D1) (figures 2, 8, 10) discloses a valve drive precisely as per claim 1, with a steel disc (end part of the cylindrical outer element of the play-compensating element 4) serving as stop element.

Therefore, the subject matter of claim 1 is not novel within the meaning of PCT Article 33(2).

**V.2 Dependent claims**

Dependent claims 2 to 10 appear to meet the requirements with regard to novelty, inventive step and industrial applicability of PCT Article 33(2) to (4).

**V.3 Industrial applicability**

The subject matter of claims 1-10 is functional and can be manufactured and therefore is also industrially applicable.